Supreme Court, U. S.
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No. 80-287

IN THE

Supreme Court of the United States

OCTOBER TERM, 1980

SYLVAN R. SHEMITZ, *Petitioner,*

v.

DEERE & COMPANY, INC., *Respondent,*

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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PRESS OF BYRON S. ADAMS PRINTING, INC., WASHINGTON, D.C.

QUESTIONS PRESENTED

The questions presented by the petition are really nothing more than a rehash of the questions considered by the Seventh Circuit Court of Appeals and answered in favor of the respondent. In particular, the Appellate Court specifically found that the District Court had applied the correct standard required to sustain a motion for summary judgment; that the District Court properly adhered to the criteria set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966) in determining that the patent in issue was invalid for obviousness under 35 U.S.C. § 103; and that the District Court properly utilized the summary judgment route in invalidating the patent claims under 35 U.S.C. § 103.

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INTRODUCTION

No reason exists for granting the requested writ because the holding sought to be reviewed is not in conflict with the applicable decisions of this Court or with the law as applied in other Courts of Appeal. Nor does it involve any issue of public importance — constitutional, statutory or otherwise.

Rather, the lower courts' decisions constitute a conventional holding of patent invalidity on the fundamental issue of obviousness pursuant to the provisions of 35 U.S.C. § 103. Since this holding of obviousness was reached by way of summary judgment rather than after trial, petitioner raises the specter of "genuine issues of material fact". However, the reasons advanced by peti-

tioner are based upon erroneous assertions both as to the nature and character of the decisions below and as to the governing case law.

ARGUMENT

Contrary to the petitioner's assertion in its so-called "STATEMENT OF THE CASE", the District Court correctly applied the evidence in the record to the obviousness test mandated by *Graham* v. *John Deere Co.*, and the Court of Appeals specifically recognized this in its *per curiam* opinion as well by adopting the District Court's Memorandum of Decision as its own. In particular, the District Court defined the art to which the claimed subject matter pertained and the level of ordinary skill in such art at the time the alleged invention was made using, in fact, the standard defined by the petitioner himself [Petitioner's Appendix, page A6]. The District Court also fully examined the scope and content of the prior art at the time of the invention, and the differences, if any, between the prior art and the claims at issue when viewed from the previously defined level of ordinary skill in the relevant subject matter involved. [Petitioner's Appendix, pages A5-A6]. Measured against those criteria, the District Court found that the subject matter of the claims at issue was clearly obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains, thus rendering the patent claims invalid pursuant to 35 U.S.C. § 103 [Petitioner's Appendix, page A8].

The fact that the District Court summarily invalidated the patent claims in issue is likewise not a basis for review on writ of certiorari by this Court. There can be no factual dispute concerning the state of the prior art set forth in the District Court's decision.

Nor can there be any valid argument that the subject matter of such prior art and the patent claims in suit is not readily comprehended without need for technical explanation by expert witnesses. Therefore, as has been held repeatedly, summary judgment represents a most useful legal tool under such circumstances so as to save the time and expense of all concerned. See, for example, *Centsable Products, Inc.* v. *Lemelson,* 591 F.2d 400, 402-04 (7th Cir.), *cert. denied,* 444 U.S. 840 (1979); *Research Corp.* v. *Nasco Industries, Inc.,* 501 F.2d 358, 361-62 (7th Cir.), *cert. denied,* 419 U.S. 1096 (1974); *Glagovsky* v. *Bowcraft Trimming Co.,* 267 F.2d 479, 480 (lst Cir.), *cert. denied,* 361 U.S. 884 (1959); and *Vermont Structural Slate Co.* v. *Tatco Bros. Slate Co.,* 233 F.2d 9, 10 (2nd Cir.), *cert. denied,* 352 U.S. 917 (1956).

CONCLUSION

No amount of argument can convert the holding below from a conventional finding of patent invalidity based upon 35 U.S.C. § 103. The District Court in granting summary judgment and the Seventh Circuit Court of Appeals in affirming such judgment merely recognized that it would have been a waste of time and effort to deny such a judgment particularly because the subject matter of the prior art and the patent claims at issue (a room divider-light fixture) are, without any expert aid easily understandable by anyone of modest intelligence. If the question of patentability had been a close one, then there might be some support for petitioner's plea to be given "his day in court". However, the question of obviousness in this case is not even close, so that summary judgment was singularly appropriate.

Respectfully submitted,

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